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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : M. ARONHIME et al.

Appl. No : 09/011,634

Filed : August 16, 1996 as International Application No. PCT/NL96/00323

For : INTERMEDIATE TRANSFER BLANKET AND METHOD
OF PRODUCING THE SAME



Group Art Unit : 1734

Examiner : Lorengo

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 and 372 mailed from the U.S. Patent and Trademark Office on October 8, 1999, which sets a one month shortened statutory period for response until November 8, 1999.

Applicants hereby request an extension of time for one month to extend the period for response until December 8, 1999, and are concurrently filing a formal Request for Extension of Time for one month accompanied by the government extension of time fee for one month. If for any reason the formal Request for Extension of Time is not associated with the file and/or the fee is deficient, this is an express request for any required extension of time, and authorization for the Commissioner to charge any necessary fee,

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including any required extension of time fee, to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

DISCUSSION OF RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

I. Claims 1-28, 46, 47 and 60 drawn to a method and apparatus of producing a multi-layered image transfer member.

II. Claims 29-45, 48-59 and 61-65 drawn to an image transfer member.

The Examiner contends that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because the Examiner contends that claim 29 is not novel based upon the fact that U.S. Patent No. 4,066,802 to Clemens specifically discloses an image transfer method suitable for the transfer of toner images and having an outer release layer of silicone.

ELECTION

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In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group II, claims 29-45, 48-59 and 61-65, with traverse.

For the reasons set forth below, Applicants submit that the restriction requirement is improper, and should be withdrawn, whereby an action on the merits of all of the pending claims is warranted.

TRAVERSE

Notwithstanding the election of the claims of Group II in order to be responsive to the requirement for restriction, Applicants respectfully traverse the requirement.

Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
 - (2) A product and process of use of said product; or
 - (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
 - (4) A process and an apparatus or means specifically designed for carrying out the said process; or
 - (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.
- (c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.
- (d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and w 1.476(c).
- (e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Applicants point out that in determining unity of invention the criteria set forth in 37 C.F.R. 1.475 must be considered. Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking at least under 1.475(a) and (b). Therefore, the restriction requirement is improper for not discussing the various sections of 1.475.

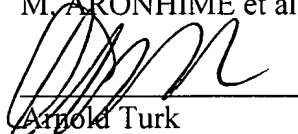
Still further, there should be no undue burden to examine all of the pending claims, because, as discussed above, the International Searching Authority has already performed a search of each of the pending claims.

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In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.



Respectfully
submitted,
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December 8, 1999
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